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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,172	05/15/2001	Yoshimasa Utsumi	450100-03223	1573
20999	7590	12/01/2005		
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER SMITH, TRACI L	
			ART UNIT 3629	PAPER NUMBER

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/858,172	<b>Applicant(s)</b> UTSUMI, YOSHIMASA	
	<b>Examiner</b> Traci L. Smith	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

1. This action is in response to papers filed on September 12, 2005.
2. Claims 1-12 are pending.
3. Claims 1-12 are rejected.

***Claim Rejections - 35 USC § 112***

4. Claims 1-12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Regarding claims 5, 9, the word "means" is preceded by the word(s) "charge processing"; "transmitting" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).
6. Claim 1 recites the limitation "the information" in ¶ 2 and 4. There is insufficient antecedent basis for this limitation in the claim.
7. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-4, 6-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,289,341 Barney; Intelligent Agent for Identifying Intellectual Property Infringement Issues in Computer Network sites and Method of Operation, in view of US Patent 5,862,620 Rhoads; Method for Surveying Dissemination of Proprietary Empirical Data.

11. As to claims 1, 6 and 12 Barney teaches receiving information about a right C. 4 I. 48-50)

- storing received information(C. 2 I. 49-52).
- Making information public(C. 2 I. 18-21).
- Receiving information regarding infringement(C. 4 I. 61-65).

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- As to the charge processing means, Barney fails to teach the effect of charge processing. However, Rhoads teaches the identifying the process of selling(charging) the material used by another. It would have been obvious to one skilled in the art at the time of invention to combine the teachings of Rhoads with Barney so as to allow users of a right to be charged for using the right held by the registered party so as to avoid infringement issues.

12. As to claims 2 and 7-8 Barney teaches the site including the data to be traversed and the examined information associated with the IP database in one embodiment(C. 1 l. 65-67).

13. As to claims 3-4 and 9-10 Rhoads teaches the benefits of royalties but fails to teach paying a continent or registration fee. It would have been obvious one skilled in the art to combine fees when the user is using a third party company to post and/or perform the information search. It is common business practice that you pay fees based on the service you have performed and also pay additional fees when those services give reward/benefits to the user.

14. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,289,341 Barney; Intelligent Agent for Identifying Intellectual Property Infringement Issues in Computer Network sites and Method of Operation, in view of US Patent 5,862,620 Rhoads; Method for Surveying Dissemination of Proprietary Empirical Data. as applied to claims 1-4, 6-10 and 12 above, and further in view of Non-patent Literature obtained form Lexis 1999 copyright; "Snitching for dollars: The economics and Public Policy of Federal Civil Bounty Programs" Ferziger, Marsha.

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15. As to claims 5 and 11 together Barney and Rhoads teach the method and apparatus of identifying information regarding possible infringement of a right. Barney and Rhoads fail to teach paying the finder for the information about the right. Ferziger teaches government agencies paying "bounties" to informers who gave information that led to the arrest of a criminal(Pg 23 ¶ 4). It would have been obvious to one skilled in the art at the time of invention to combine the teachings of Ferziger with Barney and Rhoads so as to have an incentive for users to come forth with information regarding infringement.

### ***Response to Arguments***

16. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The examiner has sited several non-patent articles below to show that the applicants invention has been applied to many areas of legal rights.

18. USA Today-Rewards Police lines often clogged with false, unreliable clues; Jack Kelley; Jan 30, 1997.

19. National Post: Ads Hit home: Stop domestic Violence: Crime stoppers Campaing.; Don Mills; Oct. 27, 1999.

20. Tulsa World: Tulsa's Most Wanted Listed on Websites. Aug. 01, 1996.

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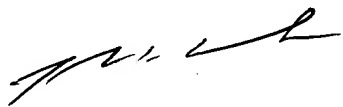
21. Lexis article "The Private Police"; April 1999. David Sklansky.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 572-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TLS



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